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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/967,272	09/28/2001	Carlton Bartels	CF-55	6788
1473	7590	09/13/2005	EXAMINER	
FISH & NEAVE IP GROUP ROPES & GRAY LLP 1251 AVENUE OF THE AMERICAS FL C3 NEW YORK, NY 10020-1105			CAMPEN, KELLY SCAGGS	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 09/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/967,272	BARTELS ET AL.	
	Examiner Kelly Campen	Art Unit 3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-6,8-14 and 16-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-6, 8-14, 16-22 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____.

DETAILED ACTION

This Office Action is in response to the Amendment filed on 3-30-05. Currently, claims 1-6, 8-14 and 16-22 are pending in the application.

Claim Objections

Claim 22 is objected to because of the following informalities: typographical error, non-English spelling, “organization” should be written -- organization--. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The previous rejection of claims 1-6, 8-14 and 17-21 under 35 U.S.C. 103(a) as being unpatentable over the Pugliese III, et al. publication (US 2001/0044751 A1) in view of the Messmer et al. patent application (US 2001/0037278) is herein maintained.

The previous rejection of claim 16 under 35 U.S.C. 103(a) as being unpatentable over Pugliese reference as applied to claim 1 above, and further in view of Sowinski (US 6,601,033 B1) is herein maintained.

Claims 1-6, 8-14 and 17-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pugliese reference in view of Messmer et al. (US 2001/0037278) and further in view of Sowinski (US 6,601,033 B1).

The Pugliese reference discloses a method for simulating trading using an electronic trading application, comprising:

Allowing a user to participate in an electronic trading simulation (page 1, paragraph 0008 - simulates live auction) and allowing a simulation administrator to modify parameters in connection with the electronic trading simulation in real-time (page 1, paragraph 0008 – real time)(claims 1 and 21).

The Pugliese references lacks:

disclosing that the trading is of carbon dioxide equivalents,
the system is for a simulating trading, and
allowing the user to generate internal reductions in connection with an organization selected to participate in the electronic trading simulation.

The Sowinski reference teaches allowing the user to trade carbon monoxide equivalent emission reductions using the electronic trade application (col. 1, lines 43-54 – exchanges and col. 6, line 64- carbon monoxide reductions)(claim 1 and 16).

Since Pugliese discloses a trading system for any type of good, and also since Sowinski discloses a trading system specifically geared toward carbon monoxide reductions, it would have been obvious to combine the “goods” (i.e. carbon monoxide reductions) of the Sowinski patent with the “goods” of the Pugliese patent so as to reach an expansive audience yet provide a reasonable means of trading reductions.

Also, although the Sowkinski reference specifically discloses a system for carbon *monoxide* emission reductions, the Examiner takes Official Notice that the actual number of carbon molecules present in the emission is irrelevant to the trading system therefore. It would

be obvious to use the same trading system for carbon *monoxide* and for carbon *dioxide* emission reductions since the actual process is really directed to the trading of a good, in this case an emission reduction. And the trading system is capable of working with any type of good that would encompass both carbon monoxide emission reductions as well as carbon dioxide emission reductions.

The Messmer patent teaches simulating a bidding system so that bid scenarios can be examined and the best bid prices according to risk and return be determined (Messmer – Abstract) (claim 1).

It would have been obvious to one of ordinary skill in the art to modify the Pugliese system to include that it may be used for simulating a bidding system so as to provide users with a mechanism that will give them the best optimal conditions prior to entering an actual market.

Also, the Examiner takes the position that it is well known in the computer art that “tests” of computer programs are run prior to actually launching such systems, and such tests are considered by the Examiner to be “simulations” of the actual program. Also, since there is no appreciable difference between the actual process and the simulated process, it is the Examiner’s position that the processes are the same, that is the computer system disclosed in the Pugliese system would be the same and perform the same, whether it were used for a simulation or for an actual auction, as such it anticipates the presently claimed invention since the underlying computer systems are essentially the same. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made that the Pugliese system could have been used as a simulated trading system.

The Pugliese patent application also discloses:

Allowing the administrator to log on (page 7, paragraph 0139 – ShopLive Administrators, it is inherent in an online system that the participants must log on to the system)(claim 2);

Allowing the administrator to modify a real-time timeline (page 20, paragraph 0375 – scheduled events)(claim 3);

Allowing the administrator to create a news announcement (page 20, paragraph 0375 - notifications)(claim 4);

Allowing the administrator to release the news announcement (page 20, paragraph 0375 - notifications)(claims 5 and 6);

Allowing the administrator to modify parameters in connection with an organization that is participating in the simulation (page 7, paragraph 0139)(claim 8);

Allowing the administrator to modify parameters in connection with a country that is participating in the simulation (page 7, paragraph 0139)(claim 9);

Allowing the user to log on (page 13, paragraph 250)(claim 10);

Allowing the user to review information about the electronic trading simulation (page 7, paragraph 0135 & 0136)(claim 11);

Allowing the user to select an organization to participate in the simulation (page 10, paragraph 0194 & 0195)(claim 12);

Allowing the user to review the position of an organization selected to participate (page 10, paragraph 0194 & 0195)(claim 13); and

Allowing the user to generate credits in connection with an organization selected to participate (page 22, paragraph 0387 - incentives)(claim 14).

The Pugliese references lacks:

Allowing the user to trade carbon dioxide equivalent emission reductions using the electronic trading application (claim 16).

The Sowinski reference teaches allowing the user to trade carbon monoxide equivalent emission reductions using the electronic trade application (col. 1, lines 43-54 – exchanges and col. 6, line 64- carbon monoxide reductions)(claim 16).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Pugliese reference with the teachings of the Sowinski reference because an auction system allows for buyers and sellers in various geographic regions to trade excess emission reductions while allowing those in need to acquire such reductions. Since Pugliese discloses a trading system for any type of good, and also since Sowinski discloses a trading system specifically geared toward carbon monoxide reductions, it would have been obvious to combine the “goods” of the Sowinski patent with the auction of the Pugliese patent so as to reach an expansive audience yet provide a reasonable means of trading reductions.

Also, although the Sowinski reference specifically discloses a system for carbon monoxide emission reductions, the Examiner takes Official Notice that the actual number of carbon molecules present in the emission is irrelevant to the trading system therefore. It would be obvious to use the same trading system for carbon *monoxide* and for carbon *dioxide* emission reductions since the actual process is really directed to the trading of a good, in this case an emission reduction. And the trading system is capable of working with any type of good that

would encompass both carbon monoxide emission reductions as well as carbon dioxide emission reductions.

The Pugliese references also discloses:

Allowing the user to review a news announcement (page 20, paragraph 0375 - notifications)(claim 17);

Allowing the user to review a late breaking news announcement (as best understood -- page 20, paragraph 0375- notifications)(claim 18);

Allowing the user to review a timeline of sessions of the electronic trading simulation (page 20, paragraph 0375 – scheduled events)(claim 19); and

Allowing the user to review a report at the end of the electronic trading simulation (page 4, paragraph 80 - reports)(claim 20); and

Although Pugliese does not expressly show allowing the user to generate internal reductions in connection with an organization selected to participate in the electronic trading simulation, such is considered to be merely non-functional descriptive language and are not functionally involved in the steps recited. This type of information is merely descriptive and will not distinguish the claimed invention from the prior in terms of patentability. Such terminology such as “allowing” or “allows” only requires the system or apparatus to be ‘capable’ of performing the steps, not necessarily that such steps are actually performed, it is not a positive claim limitation. In this case, the Pugliese patent would be capable of allowing the user to generate internal reductions with the recited simulated shopping system disclosed in [0008] (claim 22).

Response to Arguments

Applicant's arguments filed 3/30/05 have been fully considered but they are not persuasive. For specific reference to the motivation to combine the references, applicant is referred back to the rejections set forth above in the instant Office Action.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation for the rejection is found in the knowledge generally available to one of ordinary skill in the art and in addition, in the references as cited in the above rejection..

In response to applicant's argument that the examiner has combined an excessive number of references, reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention. See *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991).

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Since the applicant did not traverse the examiner's assertion of official notice, the common knowledge or well-known in the art statement is taken to be admitted prior art because applicant failed to traverse the examiner's assertion of official notice. To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art.¹ A general allegation that the claims define a patentable invention without any reference to the examiner's assertion of official notice would be inadequate. See 37 CFR 1.104(d)(2).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 3624

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kelly Campen whose telephone number is (571) 272-6740. The examiner can normally be reached on Monday-Thursday

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-6584.

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ksc

¹ See 37 CFR 1.111(b). See also *Chevenard*, 139 F.2d at 713, 60 USPQ at 241 ("[I]n the absence of any demand by appellant for the examiner to produce authority for his statement, we will not consider this contention.").

VINCENT MILLIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

